

REMARKS

Claims 1-20 are pending in the Application. Claims 1-6 have been amended. Claims 13-20 have been added. The Specification has been amended to correct typographical errors. No new matter has been added. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

Support for claim 19 may be found in the disclosure and claims, for example note the Specification at page 18, line 5 to page 19, line 6, and at page 37, line 20 to page 38, line 10.

The Legal Standard

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Before a claim may be rejected on the basis of obviousness, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as prima facie obviousness. To establish prima facie obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. MPEP § 2142.

Absent a showing of a teaching, suggestion, or motivation to produce a claimed combination, an obviousness rejection is not proper. *Panduit Corp. v. Denison Mfg. Co.*, 810

F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The teaching, suggestion or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

It is respectfully submitted that the Action does not meet these burdens.

Anderson

Anderson et al ("Anderson") is directed to a system and method for delivering financial services. The distributed system includes a Conductor system architecture network. The system permits client components and server components to work in concert to provide timely financial information to users of an on-line financial information system built using Conductor. The system permits users to review activity and balances relating to different types of accounts (col. 1, lines 10-16; col. 2, lines 1-2).

Anderson's Conductor system is a sophisticated computer software system based on distributed system technology. Within the system, use of the TCP/IP protocol suite for communications with major components of the system allows the financial services to be accessed through the Internet (col. 1, lines 56-60). The Conductor system architecture is built on a common object request broker architecture (CORBA) compliant distributed object computing platform. Primary system components include financial object servers, distributed name servers, and database servers (col. 3, lines 17-23).

The 35 U.S.C. § 102 Rejections

For brevity the Applicants do not necessarily present all of the reasons as to why the reference does not anticipate the claims. Applicants reserve the right to later present additional reasons. Nevertheless, Applicants' arguments herein show that the reference does not disclose each and every step, feature, and relationship of the claimed invention arranged in the manner recited in the claims, as is required to sustain the rejections. Therefore, the applied reference cannot anticipate the claims. Hence, Applicants' claims patentably distinguish over the applied reference. Therefore, it is respectfully submitted that the 35 U.S.C. § 102(e) rejections should be withdrawn.

The Claims Are Not Anticipated By Anderson

In the Action claims 1-6 and 10-12 were rejected under 35 U.S.C. § 102(e) as being anticipated by Anderson. These rejections are respectfully traversed.

Claim 1

Anderson does not teach the recited features and relationships. Anderson does not teach an automated transaction machine including at least one transaction function device, a computer, and software in the manner recited. Anderson does not teach an automated transaction machine with the capability to access an HTML document which corresponds to the availability of transaction function devices in the automated transaction machine.

The Action alleges that Anderson's network system architecture is equivalent to the recited automated transaction machine. The Applicants disagree. Anderson's distributed system

cannot constitute the recited machine. Automated transaction machines have well known meaning in the art. For example, note Specification page 1.

The Action further apparently relies on Anderson's network clients/servers ("servers") as the recited "transaction function device." The Applicants disagree. Anderson does not teach a transaction function device in an automated transaction machine in the manner recited. An available transaction function device is selectively operative to carry out a transaction function. It is unclear how alleged servers in Anderson can be viewed by the Office as a transaction function device in the manner recited. Thus, a server in Anderson cannot constitute a transaction function device in the manner recited. It follows that Anderson cannot teach the recited automated transaction machine.

Anderson also does not teach software capable of enabling a computer to access an HTML document which corresponds to the availability of transaction function devices in the automated transaction machine. That is, Anderson does not correlate the transaction function devices available in an automated transaction machine to which document is accessed.

Even if it were somehow possible for the distributed system in Anderson to constitute the recited machine (which Anderson doesn't), and for the servers in Anderson to constitute each transaction function device (which Anderson doesn't), then Anderson would still not teach the capability to access an HTML document corresponding to the available transaction function devices (alleged servers) in the machine. Anderson lacks any teaching whatsoever of determining available transaction function devices (alleged servers). It follows that Anderson lacks the capability to access an HTML document which is based on the available transaction function devices (alleged servers) in the machine. Where does Anderson teach software capable

of enabling a computer to access an HTML document which is based on the availability of servers in an automated transaction machine?

Furthermore, Anderson is not concerned with the "type" of transaction function that can be carried out by a respective available transaction function device (alleged as servers). There is nothing in Anderson that links an HTML document to the different types of available transaction functions. That is, Anderson does not teach using an HTML document correlating to hardware status (the availability of transaction function devices). Nor does Anderson teach the recited arrangement which includes an automated transaction machine operative to access a hardware-corresponding HTML document. It follows that servers in Anderson cannot constitute a transaction function device. Nor does Anderson teach the recited software.

In an exemplary embodiment of the recited invention the apparatus has the flexibility to change the operation and customer interface of the ATM machine to respond to changing machine conditions (e.g., Specification page 37, line 20 to page 38, line 10; and page 18, line 5 to page 19, line 6). Conditions may change so that certain transaction functions are not available. For example, an ATM of the recited invention may have the ability to accept deposits until its depository is full. Then the machine may change the HTML documents it accesses to display different messages to users so that the deposit option is no longer offered. As a result the machine avoids displaying documents which include references to transactions which are not available. Hence, in the exemplary embodiment, the ATM would be able to access a (different) HTML document which corresponds to the availability of the transaction function devices in the machine. Anderson does not teach the features and relationships.

Applicants respectfully submit that Anderson does not disclose each and every element of the claimed invention arranged in the manner recited in the claim, as is required to sustain the rejection. Therefore, Anderson cannot anticipate the claim.

Claim 2

Anderson does not teach a machine including different types of transaction function devices. The Action alleges servers in Anderson as the recited transaction function devices. Even if it were somehow possible for Anderson to have servers which constituted the recited transaction function devices (which Anderson doesn't), then Anderson would still fail to teach that the servers are of different types.

Nevertheless, Anderson also does not teach that a computer operates a browser to access an HTML document by generating an address, wherein at least a portion of the address is indicative of at least one of the types of transaction function devices in the machine. Where does Anderson teach to generate an address indicative of a type of transaction function device in an automated transaction machine? The cited sections do not disclose an address or an address indicative of a type of transaction function device. Thus, Anderson does not anticipate the claim.

Claim 3

Anderson does not teach an automated transaction machine including a transaction function device having a depository. In an exemplary embodiment of the recited invention the apparatus has a banking depository (44) for accepting deposits into a secure location in the automated transaction machine.

The cited sections of Anderson refer to a firewall (20) between a router (18) and a web server (22). Applicants request evidence showing that a network firewall is used to accept deposits (i.e., a depository). Anderson's firewall has no relation to the recited depository.

Furthermore, the Action has alleged that servers in Anderson constitute transaction function devices. However, it is unclear how a server (alleged transaction function device) can include a depository. Thus, Anderson does not anticipate the claim.

Claim 4

Anderson does not teach that a server is operative to deliver a document responsive to the availability of a particular type of transaction function device in the automated transaction machine. Anderson neither teaches the availability of a transaction function, or the availability of a particular type of transaction function device, or that a server is operative to deliver a document responsive to the availability. Thus, Anderson cannot anticipate the claim.

Claim 5

Anderson does not teach an automated transaction machine having an available transaction function device including a sheet dispenser, and not having an available transaction function device including a depository for carrying out deposit transactions. Especially when the Action alleges in regard to claim 3 that Anderson has a depository. Nor does Anderson teach the document delivered by the server (claim 4) includes no reference to a deposit transaction. The Action is silent as to where Anderson teaches the recited features and relationships. Anderson does not anticipate the claim.

Claim 6

Anderson does not teach a machine including a sheet dispenser and a depository. Nor does Anderson teach that the document delivered by the server (claim 4) includes reference to both a dispense transaction and a deposit transaction. The Action is silent as to where Anderson teaches a sheet dispenser in the machine. It follows that Anderson does not teach the recited features and relationships. Hence, Anderson does not anticipate the claim.

Claim 10

Anderson does not teach providing first and second HTML documents and accessing either the first or the second document in the manner recited.

The Action alleges (Action page 3) that Anderson's network system architecture is equivalent to the recited automated transaction machine. The Applicants disagree. Anderson's distributed system cannot constitute the recited machine. Automated transaction machines have well known meaning in the art. For example, note Specification page 1.

The Action further apparently relies on Anderson's network clients/servers ("servers") as transaction function devices. The Applicants disagree. Anderson does not teach an automated transaction machine with the capability of including a transaction function device(s) in the manner recited. The transaction function device(s) is selectively operative to carry out a transaction type. It is unclear how a server in Anderson can be viewed by the Office as a transaction function device in the manner recited. Thus, a server in Anderson cannot constitute a transaction function device in the manner recited. It follows that Anderson cannot teach the recited automated transaction machine.

The Action is silent as to Anderson teaching plural HTML documents including a respective reference. Applicants respectfully submit that Anderson does not teach a first HTML document having a first reference to a first transaction type carried out by a first transaction function device. Nor does Anderson teach a second document having a second reference to a second transaction type carried out by a second transaction function device. It follows that Anderson cannot access either the first or the second document based on machine conditions.

There is no teaching that Anderson's "machine" is capable of having more than one condition. Anderson provides no teaching of a machine having a first condition comprising a first transaction function device but not a second transaction function device. Nor is there a showing in Anderson of a machine having a second condition comprising both the first and the second transaction function devices. Nor does Anderson teach accessing either a first or second document based on the machine condition. It follows that Anderson does not teach either accessing a first document when the machine includes a first transaction function device but not a second transaction function device, or accessing a second document when the machine includes both first and second transaction function devices.

Even if it were somehow possible for the distributed system in Anderson to constitute the recited machine (which Anderson doesn't), and for the clients/servers in Anderson to constitute the recited transaction function devices (which Anderson doesn't), then Anderson would still not teach the capability to determine which HTML document would be accessed based on which transaction function devices the machine includes. The claim recites that each of the documents is accessible, therefore it would appear (based on the allegation that servers constitute the transaction function devices) that Anderson's machine would have to include a first transaction

function device (alleged as a first server) and a second transaction function device (alleged as a second server) to make the respective first and second documents accessible. However, there is no teaching in Anderson that a first document is accessed when the machine includes a first transaction function device but not a second transaction function device, especially when Anderson would require the second server (alleged second transaction function device) to make the second document accessible. In a further example, it is unclear how Anderson could make a second document accessible (via a second server), and access the second document when the machine includes both a first server and the second server. That is, there is no teaching that Anderson would require both a first server and the second server to access a second document. It follows that in Anderson there is no relationship to accessing a particular document based on which transaction function devices a machine includes. The cited sections of Anderson also fail to teach the recited features and relationships. Therefore, Anderson cannot anticipate the claim.

Claim 11

As previously discussed, Anderson does not disclose the accessing step. It follows that Anderson does not teach that a first document is accessed at a first address, and a second document is accessed at a second address. Thus, Anderson does not anticipate the claim.

Claim 12

Anderson does not teach delivering device data, representative of the transaction function devices included in the machine, to a server. Nor does Anderson teach that a document accessed in the accessing step is accessed responsive to the device data. The Action is silent as to Anderson teaching device data in the manner recited. The Action is silent as to correlating the accessing of a particular document with device data of transaction function devices. Anderson

does not teach accessing either a first or second HTML document based on data representative of transaction function devices in an automated transaction machine. Therefore, Anderson cannot anticipate the claim.

**The Pending Claims Are Not Obvious Over
Anderson in view of Official Notice**

In the Action claims 7-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Official Notice. These rejections are respectfully traversed.

Claim 7

The Action alleges that Anderson's network system architecture is equivalent to the recited automated transaction machine. The Action further apparently relies on Anderson's network clients/servers ("servers") as the recited "transaction function devices." The Applicants disagree. As previously discussed, Anderson's distributed system cannot constitute the recited machine. Nor can servers in Anderson constitute the recited transaction function devices. Claim 7 recites some subject matter similarly corresponding to subject matter in claims 1 and/or 10. Applicants' remarks in support of the patentability of claims 1 and 10 are incorporated by reference as if fully rewritten herein.

Anderson does not teach the recited features and relationships. Anderson does not teach an automated transaction machine in operative connection with a memory including data representative of a plurality of transaction function devices in the machine. Nor does Anderson teach the ability to communicate representative data to a server which is operative, responsive to receipt of the data, to deliver an HTML document to a browser, wherein a computer is operative responsive to the HTML document to operate an output device. That is, Anderson does not

relate an output device operation in an automated transaction machine to data representative of a plurality of transaction function devices in the automated transaction machine.

The Action is silent as to where Anderson teaches memory including device data representative of a plurality of transaction function devices (alleged as servers) in the machine. It is unclear where Anderson has data representative of servers (alleged transaction function devices) stored in a memory. The Action is also silent as to how Anderson is able to communicate this memory data to a server to obtain an HTML document for output device operation. Nor does Anderson disclose or suggest the recited features and relationships.

The Action is also silent as to where Anderson discloses that a computer is operative responsive to the HTML document to operate an output device. The Action admits that Anderson does not teach an output device (Action page 5). The Action takes official notice of an output device as a printer.

Applicants respectfully traverse the official notice assertion on the basis that it is not supported by any reference to prior art. The Patent Office is not permitted to rely merely on assertions of “official notice” as the basis for rejecting claims, and when challenged is required to establish such assertions in the proper manner through citation to prior art. MPEP § 2144.03.

Applicants challenge the rationale that a printer output device is well known in the manner recited. Applicants request evidence of an automated transaction machine printer that is able to be operated by a computer responsive to an HTML document delivered to a browser by a server receiving data representative of a plurality of transaction function devices in the machine. That is, the evidence must show that the operation of the printer is related to the HTML

document, and that the printer has the recited relationships. Compliance by the Office with MPEP § 2144.03 is respectfully requested.

Furthermore, even if it were somehow possible for Anderson to have a printer output device (which Anderson doesn't), then there would still be no indication that the printer would be operated responsive to an HTML document. Anderson (modified with a printer) would still not disclose or suggest an automated transaction machine output device in the manner recited. It follows that Anderson (modified with a printer) would still not disclose or suggest an automated transaction machine in the manner recited.

Applicants respectfully submit that it would not have been obvious to have modified Anderson with the alleged teachings of the official notice. Applicants further respectfully submit that the official notice cannot overcome both the admitted and previously discussed deficiencies of Anderson as it does not disclose or suggest the recited features and relationships which are not found in Anderson. Neither Anderson nor the official notice taken alone or in combination disclose or suggest the recited features and relationships. Thus, it would not have been obvious to have modified Anderson with the official notice in the manner alleged to have produced the claimed invention.

Claim 8

Anderson does not teach that a computer in an automated transaction machine is operative responsive to an HTML document, which includes instructions to operate an output device, to operate the output device in the manner recited. Thus, it would not have been obvious to have modified Anderson with the official notice in the manner alleged to have produced the claimed invention.

Claim 9

Anderson does not teach server software in operative connection with a server in the manner recited. Anderson does not teach that server software is operative to generate an HTML document responsive to the receipt of data representative of a plurality of transaction function devices in an automated transaction machine. Anderson does not teach the ability to communicate data (representative of a plurality of transaction function devices in an automated transaction machine) to a server which is operative to generate (responsive to receipt of the data) and deliver an HTML document to a browser, wherein a computer is operative responsive to the HTML document to operate an output device. Thus, it would not have been obvious to have modified Anderson with the official notice in the manner alleged to have produced the claimed invention.

Request For Priority Acknowledgment

Applicants request acknowledgment of their claims for domestic priority under 35 U.S.C. § 119(e). This application claims the benefit of several provisional applications, including U.S. Provisional Application No. 60/031,956 filed November 27, 1996.

Fees For Additional Claims

Please charge the fees associated with the submission of one additional independent claim (\$80) and any other fee due to deposit account 09-0428.

Versions With Markings To Show Changes Made

In the Specification

Paragraph beginning on Specification page 23, line 6 and ending on Specification page 23, line 13:

Returning to the sample transaction, in response to receiving the enable card reader message from the device application portion 84, the device server 92 is operative to generate a message through the intranet 16 to the device interfacing software portion 64 of the ATM 12. This message which comprises an HTTP record including instructions for operating the card reader, is directed to the IP port indicated 74 which is where the device interfacing software portion 64 communicates. In response to receiving this message, the software portion 64 is operative to send a message or messages on the control bus 50 which enables card reader mechanism 38 [34].

Paragraph beginning on Specification page 23, line 14 and ending on Specification page 24, line 2:

Continuing with the transaction as shown in Figure 6, the input of the card by the customer to the card reader 38 [34] is operative to cause the card data to be read and the device interfacing program portion 64 to send a message to the device server 92 indicating the card data has been read. This message is transmitted by the device server through the intranet 16 to the

device application portion 84. The device application portion then sends a message to the device server requesting the card data. The device server 92 transmits a message with instructions to deliver the card data from the device interfacing software portion 64 which responds with a message sending the card data through the intranet to the device server. The device server, if there is no basis for stopping the transaction, transmits an HTTP record including card data back through the intranet 16 to the device application portion 84.

Paragraph beginning on Specification page 70, line 10 and ending on Specification page 70, line 16:

Figures 28-30 include schematic depictions of examples of the operation of the keyboard mapper and the keypad applet. Figure 27 [29] shows an example of an input to the keypad 168. In this example the keypad applet 170 generally in response to instructions in an HTTP record such as an HTML document or other events, transmits and enables events to the transaction services application 146. In response a mapset is selected from the database 176 corresponding to the particular map name. The keyboard command server is further operative to enable the appropriate keys of the ATM.

In the Claims

1. (once amended) Apparatus comprising:

an automated transaction machine located at a first location, wherein the machine includes [including]:

at least one [type of] transaction function device in the machine, wherein the at least one transaction function device includes at least one available transaction function device, wherein [the type] each respective available transaction function device is selectively operative to carry out a respective different type of transaction function;

a computer, wherein the computer is in operative connection with [the] each transaction function device;

software executable in the computer, wherein the software includes a browser, wherein the software is operative to enable the computer [operates the browser] to access an HTML document [responsive to the type of] which corresponds to the availability of the transaction function [device] devices in the machine.

2. (once amended) The apparatus according to claim 1 wherein the machine includes [a plurality of] different types of transaction function devices, and wherein the computer operates the browser to access the document by generating an address, and wherein at least a portion of the

address is indicative of at least one of the types of transaction function devices included in the machine.

3. (once amended) The apparatus according to claim 1 wherein the [type] machine includes a transaction function device including [includes] a depository.

4. (once amended) The apparatus according to claim 1 and further comprising a server, wherein the server is operative to deliver at least one document to the browser, wherein the document is delivered responsive to the [one] availability of a particular type of transaction function device in the machine.

5. (once amended) The apparatus according to claim 4 wherein the particular type of transaction function device in the machine includes a sheet dispenser, and wherein the machine does not include an available transaction function device including a depository for carrying out deposit transactions, and wherein the one document delivered by the server includes no reference to a deposit transaction.

6. (once amended) The apparatus according to claim 4 wherein the available transaction function devices in the machine include a sheet dispenser for carrying out a dispense transaction and a depository for carrying out deposit transactions, and wherein the one document the server is operative to deliver to the browser includes a reference to both a dispense transaction and a deposit transaction.

Conclusion

Each of Applicants' pending claims specifically recite features and relationships that are neither disclosed nor suggested in any of the applied art. Furthermore, the applied art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Applicants' invention. Allowance of all of Applicants' pending claims is therefore respectfully requested.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Examiner's convenience.

Respectfully submitted,



Ralph E. Jocke Reg. No. 31,029
WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256
(330) 721-0000